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EXAMINER
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BRANDENBURG, WILLIAM A

ART UNIT	PAPER NUMBER
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3622

NOTIFICATION DATE	DELIVERY MODE
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02/03/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/748,681	<b>Applicant(s)</b> KONINGSTEIN, ROSS	
	<b>Examiner</b> WILLIAM A. BRANDENBURG	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/13/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/13/2009 has been entered.

***Response to Amendment***

2. The following is a Non-Final Office Action in response to communications received on 11/13/2009 for Request for Continued Examination (RCE). No claims have been cancelled. Claims 1-3, 5, 13, 18-20, 22, 30, 35-37, 39, 47, 49 and 52 have been amended. Claim 53 has been added. Therefore, claims 1-53 are pending and addressed below.

***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 11/13/2009 was filed after the mailing date of the Final Office Action on 09/03/2009. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 112***

4. The amendment filed on 11/13/2009, has corrected the 35 U.S.C. 112 1<sup>st</sup> paragraph deficiencies identified in the Office Action dated 09/03/2009. Thus, the Examiner hereby withdraws the 35 U.S.C. 112 1<sup>st</sup> paragraph rejections of claims 1-2, 18-19 and 35-36 that were raised in the Office Action dated 09/03/2009.
5. The amendment filed on 11/13/2009, has **NOT** corrected the 35 U.S.C. 112 2<sup>nd</sup> paragraph deficiencies with respect to claims 18-34 identified in the Office Action dated 03/19/2009. Thus, the Examiner hereby maintains the 35 U.S.C. 112 second paragraph rejections of claims 18-34 that were raised in the Office Action dated 03/19/2009 and 09/03/2009. See below for further detail.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 18-35 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the first electronic document" in the first "delivering" step. There is insufficient antecedent basis for this limitation in the claim. Claims 18, 35 and 53 contain similar issues.

Claim 1 recites "including the electronic advertisement in the second electronic document" and "delivering...the second electronic document including the electronic advertisement". (*emphasis added*) However, it is unclear to the Examiner in what display format is the electronic display format displayed in. For the purposes of examination, the Examiner will interpret any display format to satisfy the limitation. Claim 18 contains similar issues.

As per claim 18, claim elements "electronic advertisement identification means", "electronic advertisement delivery

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means", "selection receiving means", "electronic advertisement identifying means", and "electronic advertisement including means" are means (or step) plus function limitations that invoke 35 U.S.C. 112, sixth paragraph as well the Applicant's intention to invoke on the record in the amendment filed 11/13/2009. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. The Examiner can find no clear, explicit description on what structural elements are actually performing the claimed function.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more

information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

***Claim Rejections - 35 USC § 101***

7. The amendment filed on 11/13/2009 and as per the "Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101" effective August 24, 2009, the 35 U.S.C. 101 deficiencies identified in the Office Action dated 09/03/2009 have been corrected. Thus, the Examiner hereby withdraws the 35 U.S.C. 101 rejections of claims 1-17 that were raised in the Office Action dated 09/03/2009.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-12, 14-15, 18-29, 31-32, 35-46 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Petropoulos et al. (US 2003/0146939 A1) (hereinafter Petropoulos).**

9. As per claim 1, Petropoulos discloses a computer-implemented method for advertising comprising the steps of:

identifying, at a server, an electronic advertisement, the electronic advertisement including, a compact display format, an expanded display format, and code a client device uses to transition the electronic advertisement from the compact display format into the expanded display format, the compact display format including an associated expansion icon, and the expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, upon action of pointer (i.e. mouse-over) embedded preview window opened and relevant contextual information inline with user's results rendered, actual content or web page referred by or associated with first result 53 as preview information, see also [0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page, see also

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[0065-70], operation done at the server, see also Fig. 1, "53", "63/64", "55", "57", "59");

delivering, from the server at a first time, the first electronic document including the electronic advertisement, the electronic advertisement initially displayed in the first electronic document in the compact display format ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, see also Fig. 1, "53", "63/64", "55", "57", "59");

receiving, at the server, a user selection of one of the one or more menu options after the compact display format of the electronic advertisement has been transitioned into the expanded display format in the first electronic document ([0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page);

identifying a second electronic document including content from the referenced network location associated with the menu option selected ([0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a

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link within previewed page is active and result in a call to the referenced page); and

wherein the delivering, from the server at a first time, receiving, including, and delivering, from the server at the second later time are performed by one or more computers ([0064-70], typical network system, operations performed at the client machines and the server, see also Fig. 6).

Petropoulos does not explicitly disclose

including the electronic advertisement in the second electronic document; and

delivering, from the server at a second later time, the second electronic document including the electronic advertisement.

However, Petropoulos does teach that actual content or the web page referred by or associated with first result 53 is displayed as preview information ([0020-24]). This preview information is displayed in preview window 55. The user may control functional attributes of the preview window including hyperlinks in which a mouse-over or click on a link within the previewed page results in a call to the referenced page ([0042], see also Fig. 1, "53", "63/64", "55", "57", "59").

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include delivering a second document including the referenced content and the electronic advertisement initially displayed in the expanded format. The rationale for this inclusion is that this would enable Petropoulos to deliver the content while maintaining the advertising content in direct view of the user. Common sense dictates that the longer a user is subjected to particular content, the more impact and effect the content could have on the user. The Examiner notes that although the particular language of the instant invention is not explicitly disclosed in Petropoulos, based on the broadest reasonable interpretation, the Examiner understands the actual content or web page that is displayed as preview information to be the expanded display format of the instant invention.

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Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements. As such, the Examiner contends the limitations as currently written have been satisfied by the provided recitations and rationale.

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10. As per claim 2 (as similarly as per apparatus claims 19 and 36), Petropoulos discloses the computer-implemented method of claim 1 (as rejected above).

Petropoulos does not explicitly disclose wherein one of the menu options includes a home menu option and further comprising:

receiving a selection of the home menu option; and  
delivering the first electronic document including the electronic advertisement and enabling display to the user of the first electronic document in the compact display format.

However, Petropoulos does teach preview information is displayed in preview window 55. The user may control functional attributes of the preview window including hyperlinks in which a mouse-over or click on a link within the previewed page results in a call to the referenced page ([0042], see also Fig. 1, "53", "63/64", "55", "57", "59"). In addition, Petropoulos teaches advanced preview icon implementation including separating regions in the preview icon which allows the user to dynamically and automatically determine what to preview via a variety of menu buttons ([0060-61], see also Fig. 5, "552", "Home Page"). Furthermore, Petropoulos teaches a mouse-over technology in which the user

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may simply move the pointer away from the preview and the window will close and return to the original display ([0054]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include a home menu option to return to the original display. The rationale for this inclusion is a home option allows a user to easily return to the original content display to avoid the hassle of the typical backward-forward movement in a browser setting. The Examiner notes that although Petropoulos teaches various menu options, but does not explicitly teach a home option specifically in the preview window (i.e. expanded display), the taught menu options (i.e. functional attribute hyperlinks [0042]) could easily include a home menu option. Furthermore, there are a limited number of predictable ways to transition back to the original format. For example, one could either close the preview window (i.e. expanded display) by clicking a typical close "x" button, select a coded "home" button as disclosed in the instant application, or "deselect" (i.e. move away the cursor) the window as is taught by Petropoulos. As such, it would be obvious for Petropoulos to include a home menu option as opposed to its current teachings because the mouse-over technology yields the same functionality of returning to the original display format that

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the home menu option provides. The Examiner notes this rationale has been based on the interpretation resulting from the 112 2nd paragraph rejection detailed above.

11. As per claim 3 (and similarly as per apparatus claims 20 and 37), Petropoulos discloses the computer-implemented method of claim 1 (as rejected above). Petropoulos further discloses wherein

the electronic advertisement comprises a morphing electronic advertisement ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, upon action of pointer (i.e. mouse-over) instructions are sent and embedded preview window opened and relevant contextual information inline with user's results rendered, actual content or web page referred by or associated with first result 53 as preview information, see also [0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page, see also Fig. 1, "53", "63/64", "55", "57", "59").

12. As per claim 4 (and similarly as per apparatus claims 21 and 38), Petropoulos discloses the computer-implemented method

of claim 1 (as rejected above). Petropoulos further discloses wherein

the first and second electronic document comprise web pages ([0010], preview information is a "preview window" containing relevant preview information of actual page or document associated with item in results list, see also [0020-25], search results web page 59, preview information displays actual content or the web page referred by or associated with the first result, see also Fig. 1, "59").

13. As per claim 5 (and similarly as per apparatus claims 22 and 39), Petropoulos discloses the computer-implemented method of claim 4 (as rejected above). Petropoulos further discloses wherein

the network locations specified in reference to the one or more menu options comprise network locations provided by or affiliated with a host entity that delivered the first electronic document or the electronic advertisement ([0025-26], preview information displays actual content or the web page referred by or associated with the first result, see also [0029], contextual information regards URL pertaining to web page, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the

referenced page as well as enabling further mouse-over, which allows the user to use mouse-over in the preview pane).

14. As per claim 6 (and similarly as per apparatus claims 23 and 40), Petropoulos discloses the computer-implemented method of claim 1 (as rejected above). Petropoulos further discloses further comprising:

wherein the electronic advertisement comprises a target reference to an advertiser network location ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page).

Petropoulos does not explicitly disclose

storing a price parameter value in association with the electronic advertisement.

However, Petropoulos does teach various constraints are used to sort the pages returned as preview information ([0027-28]). In addition, Petropoulos teaches a user's use of preview information is monitored while the user reviews the results page. More specifically, it monitors which result is being previewed by order or rank, the length of each preview,

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whether there is a click-through, etc. The attributes of user behavior are forwarded across the network and later used to improve relevancy ([0072-79]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include storing a price parameter associated with the electronic advertisement. The Examiner notes that in an electronic advertising environment, it is common for there to be a direct correlation between price and performance parameters. As such, the act of monitoring performance (i.e. user interaction) in an online environment provides a way to measure the effectiveness of the content issued to the user, whether it be search results, banner advertisements, etc. Therefore, although Petropoulos does not explicitly teach storing a price value, it would be obvious for a price value to be present as a result of the monitoring and tracking of user performance recited in the teachings of Petropoulos.

15. As per claim 7 (and similarly as per apparatus claims 24 and 41), Petropoulos discloses the computer-implemented method of claim 6 (as rejected above). Petropoulos further discloses further comprising:

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receiving a third user selection of the target reference, wherein performance is determined to have occurred upon receipt of the selection of the target reference ([0042], functional attributes of preview window include hyperlinks that a user can mouse over or click on which would result in a call to the referenced page, see also [0073-75], a user's use of preview information is monitored while the user reviews the results page, it monitors which result is being previewed by order or rank, the length of each preview, whether there is a click-through, etc., attributes of user behavior are forwarded across the network and later used to improve relevancy).

16. As per claim 8 (and similarly as per apparatus claims 25 and 42), Petropoulos discloses the computer-implemented method of claim 6 (as rejected above). Petropoulos further discloses further comprising:

receiving an indication of user activity associated with the expanded display format, wherein performance is determined to have occurred upon receipt of the indication of the user activity ([0042], functional attributes of preview window include the use of a scroll bar, hyperlinks that a user can mouse over or click on which would result in a call to the referenced page, etc., see also [0073], attributes of user behavior tracked and monitored).

17. As per claim 9 (and similarly as per apparatus claims 26 and 43), Petropoulos discloses the computer-implemented method of claim 8 (as rejected above). Petropoulos further discloses wherein

the user activity comprises a predetermined period of time viewing the expanded display format ([0042], user can dynamically control the duration of the preview window visibility, see also [0073-75], user's use of preview information monitored including the length of each preview, a long duration indicates high relevancy to a particular result).

18. As per claim 10 (and similarly as per apparatus claims 27 and 44), Petropoulos discloses the computer-implemented method of claim 8 (as rejected above). Petropoulos further discloses wherein

the user activity comprises the user request to view the expanded display format ([0010], displaying preview information associated with each result item, see also [0025], preview information shown when there is a mouse-over a defined area, see also [0073], user's use of preview information monitored including which result is being previewed).

19. As per claim 11 (and similarly as per apparatus claims 28 and 45), Petropoulos discloses the computer-implemented method of claim 8 (as rejected above). Petropoulos further discloses wherein

the user activity comprises a predetermined number of user selections of the one or more menu options available in the expanded display format ([0026], preview information include URLs, with respect to URLs used as preview information these URLs will function as links, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page as well as enabling further mouse-over, which allows the user to use mouse-over in the preview pane, see also [0073-75], a user's use of preview information is monitored while the user reviews the results page, it monitors which result is being previewed by order or rank, the length of each preview, whether there is a click-through, etc., attributes of user behavior are forwarded across the network and later used to improve relevancy).

20. As per claim 12 (and similarly as per apparatus claims 29 and 46), Petropoulos discloses the computer-implemented method of claim 1 (as rejected above). Petropoulos further discloses further comprising:

associating a reference to the electronic advertisement for use by the user in retrieving the electronic advertisement ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0029], contextual information regards URL pertaining to web page, see also [0032], preview information includes tags defining the information to be previewed).

21. As per claim 14 (and similarly as per apparatus claims 31 and 48), Petropoulos discloses the computer-implemented method of claim 1 (as rejected above). Petropoulos further discloses wherein,

the second electronic document comprises a document provided by the advertiser ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page) (The Examiner understands the actual content or web page that is displayed as preview information to be the expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page,

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the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements.).

22. As per claim 15 (and similarly as per apparatus claims 32 and 49), Petropoulos discloses the computer-implemented method of claim 14 (as rejected above). Petropoulos further discloses wherein,

the document provided by the advertiser comprises a web page from the advertiser's web site ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page) (The Examiner understands the actual content or web page that is displayed as preview information to be the second instance, or expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its

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respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements.).

23. As per claim 18, Petropoulos discloses an apparatus for delivering advertising comprising:

electronic advertisement identification means for identifying an electronic advertisement, the electronic advertisement including a compact display format, an expanded display format, and code a client device uses to transition the electronic advertisement from the compact display format into the expanded display format, the compact display format including an associated expansion icon, and the expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, upon action of pointer (i.e. mouse-over) embedded preview window opened and relevant contextual information inline with user's results rendered, actual

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content or web page referred by or associated with first result 53 as preview information, see also [0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page, see also [0065-70], operation done at the server, see also Fig. 1, "53", "63/64", "55", "57", "59");

electronic advertisements delivering means for delivering, at a first time, the first electronic document including the electronic advertisement, the electronic advertisement initially displayed in the first electronic document in the compact display format ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, see also Fig. 1, "53", "63/64", "55", "57", "59");

selection receiving means for receiving a user selection of one of the one or more menu options after the compact display format of the electronic advertisement has been transitioned into the expanded display format ([0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page); and

electronic advertisement identifying means for identifying a second electronic document including content from the referenced network location associated with the menu option selected ([0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page).

Petropoulos does not explicitly disclose

electronic advertisement including means for including the electronic advertisement in the second electronic document; and

the electronic advertisement delivering means delivering at a second later time, the second electronic document including the electronic advertisement.

However, Petropoulos does teach that actual content or the web page referred by or associated with first result 53 is displayed as preview information ([0020-24]). This preview information is displayed in preview window 55. The user may control functional attributes of the preview window including hyperlinks in which a mouse-over or click on a link within the

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previewed page results in a call to the referenced page ([0042], see also Fig. 1, "53", "63/64", "55", "57", "59").

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include delivering a second document including the referenced content and the electronic advertisement initially displayed in the expanded format. The rationale for this inclusion is that this would enable Petropoulos to deliver the content while maintaining the advertising content in direct view of the user. Common sense dictates that the longer a user is subjected to particular content, the more impact and effect the content could have on the user. The Examiner notes that although the particular language of the instant invention is not explicitly disclosed in Petropoulos, based on the broadest reasonable interpretation, the Examiner understands the actual content or web page that is displayed as preview information to be the expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second

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electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements. As such, the Examiner contends the limitations as currently written have been satisfied by the provided recitations and rationale.

24. As per claim 35, Petropoulos discloses an apparatus for delivering advertising comprising:

a server performing operations comprising  
identifying an electronic advertisement, the electronic advertisement including a compact display format, an expanded display format, and code a client device uses to transition the electronic advertisement from the compact display format into the expanded display format, the compact display format including an associated expansion icon, and the expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, upon action of pointer (i.e. mouse-over) embedded preview window opened and relevant contextual information inline with user's results rendered, actual content or web page referred by or associated with first

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result 53 as preview information, see also [0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page, see also [0065-70], operation done at the server, see also Fig. 1, "53", "63/64", "55", "57", "59");

delivering, from the server at a first time, the first electronic document including electronic advertisement, the electronic advertisement initially displayed in the first electronic document in the compact display format ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, see also Fig. 1, "53", "63/64", "55", "57", "59");

receiving, at the server, a user selection of one of the one or more menu options after the compact display format of the electronic advertisement has been transitioned into the expanded display format ([0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page);

identifying a second electronic document including content from the referenced network location associated with the menu

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option selected ([0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page).

Petropoulos does not explicitly disclose

including the electronic advertisement in the second electronic document, the electronic advertisement displayed in the second electronic document in the expanded display format; and

delivering, from the server at a second later time, the second electronic document including the electronic advertisement.

However, Petropoulos does teach that actual content or the web page referred by or associated with first result 53 is displayed as preview information ([0020-24]). This preview information is displayed in preview window 55. The user may control functional attributes of the preview window including hyperlinks in which a mouse-over or click on a link within the previewed page results in a call to the referenced page ([0042], see also Fig. 1, "53", "63/64", "55", "57", "59").

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include delivering a second document including the referenced content and the electronic advertisement initially displayed in the expanded format. The rationale for this inclusion is that this would enable Petropoulos to deliver the content while maintaining the advertising content in direct view of the user. Common sense dictates that the longer a user is subjected to particular content, the more impact and effect the content could have on the user. The Examiner notes that although the particular language of the instant invention is not explicitly disclosed in Petropoulos, based on the broadest reasonable interpretation, the Examiner understands the actual content or web page that is displayed as preview information to be the expanded display format of the instant invention.

Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements. As such, the Examiner contends the limitations as currently written have been satisfied by the provided recitations and rationale.

25. As per claim 52, Petropoulos discloses a method, comprising:

receiving at a server, from a publisher, a request for an advertisement to be included in a first electronic document associated with publisher ([0020], search query performed, see also [0065-70], searching performed, request sent to server and results returned to client device);

identifying an electronic advertisement responsive to the request, the electronic advertisement including a reference to a network location for retrieving specified content associated with the electronic advertisement ([0020], search query

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performed, search results returned as hyperlinks to webpage, see also [0065-70], searching performed, request sent to server and results returned to client device);

delivering, from the server at a first time, the electronic advertisement to be included in the first electronic document ([0020], search query performed, search results returned as hyperlinks to webpage, see also [0065-70], searching performed, request sent to server and results returned to client device);

receiving a user selection of the electronic advertisement ([0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page);

identifying a second electronic document including content from a referenced network location associated with the selected electronic advertisement ([0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page); and

wherein the delivering, from the server at the first time, receiving the user selection, including, and delivering, from

the server at the second later time, are performed by one or more computers ([0064-70], typical network system, operations performed at the client machines and the server, see also Fig. 6).

Petropoulos does not explicitly disclose

including the electronic advertisement in the second electronic document; and

delivering, from the server at a second later time, the second electronic document including the electronic advertisement.

However, Petropoulos does teach that actual content or the web page referred by or associated with first result 53 is displayed as preview information ([0020-24]). This preview information is displayed in preview window 55. The user may control functional attributes of the preview window including hyperlinks in which a mouse-over or click on a link within the previewed page results in a call to the referenced page ([0042], see also Fig. 1, "53", "63/64", "55", "57", "59").

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include delivering a second document including the referenced content

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and the electronic advertisement initially displayed in the expanded format. The rationale for this inclusion is that this would enable Petropoulos to deliver the content while maintaining the advertising content in direct view of the user. Common sense dictates that the longer a user is subjected to particular content, the more impact and effect the content could have on the user. The Examiner notes that although the particular language of the instant invention is not explicitly disclosed in Petropoulos, based on the broadest reasonable interpretation, the Examiner understands the actual content or web page that is displayed as preview information to be the expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements. As such, the Examiner contends the limitations as currently written have been satisfied by the provided recitations and rationale.

26. As per claim 53, Petropoulos discloses a computer-implemented method, comprising:

identifying, at a server, an electronic advertisement, the electronic advertisement including a reference to a network location for retrieving specified content associated with the electronic advertisement ([0020], search query performed, search results returned as hyperlinks to webpage, see also [0065-70], searching performed, request sent to server and results returned to client device);

delivering, from the server at a first time, the first electronic document including the electronic advertisement ([0020], search query performed, search results returned as hyperlinks to webpage, see also [0065-70], searching performed, request sent to server and results returned to client device);

receiving, at the server, a user selection of the electronic advertisement ([0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page);

identifying a second electronic document including content from the referenced network location associated with the

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electronic advertisement ([0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page); and

wherein the delivering, from the server at a first time, receiving, including, and delivering, from the server at the second later time are performed by one or more computers ([0064-70], typical network system, operations performed at the client machines and the server, see also Fig. 6).

Petropoulos does not explicitly disclose

including the electronic advertisement in the second electronic document; and

delivering, from the server at a second later time, the second electronic document including the electronic advertisement.

However, Petropoulos does teach that actual content or the web page referred by or associated with first result 53 is displayed as preview information ([0020-24]). This preview information is displayed in preview window 55. The user may control functional attributes of the preview window including hyperlinks in which a mouse-over or click on a link within the

previewed page results in a call to the referenced page ([0042], see also Fig. 1, "53", "63/64", "55", "57", "59").

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include delivering a second document including the referenced content and the electronic advertisement initially displayed in the expanded format. The rationale for this inclusion is that this would enable Petropoulos to deliver the content while maintaining the advertising content in direct view of the user. Common sense dictates that the longer a user is subjected to particular content, the more impact and effect the content could have on the user. The Examiner notes that although the particular language of the instant invention is not explicitly disclosed in Petropoulos, based on the broadest reasonable interpretation, the Examiner understands the actual content or web page that is displayed as preview information to be the expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second

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electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements. As such, the Examiner contends the limitations as currently written have been satisfied by the provided recitations and rationale.

**27. Claims 13, 16, 30, 33, 47 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petropoulos et al. (US 2003/0146939 A1) (hereinafter Petropoulos) in view of Ogura et al. (US 2002/0165767 A1) (hereinafter Ogura).**

28. As per claim 13 (and similarly as per apparatus claims 30 and 47), Petropoulos discloses the computer-implemented method of claim 12 (as rejected above).

Petropoulos does not explicitly disclose further comprising:

enabling the user to bookmark the electronic advertisement using the reference (The Examiner notes this claim language is still considered optional).

However, Ogura teaches a bookmark button that when pressed allows a user to easily link with the advertisement and store

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the bookmark in an advertisement log (bookmark) table ([0092], see also [0118-122]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include the capability to bookmark an electronic advertisement. The rationale for combining in this manner is that both Petropoulos and Ogura are directed to advertising via an online environment. Furthermore, this inclusion would enable Petropoulos to provide a user that ability to save desired content and easily access it again at a later time, thus increasing the likelihood of a user making a purchase or some other typical online conversion.

29. As per claim 16 (and similarly as per apparatus claims 33 and 50), Petropoulos discloses the computer-implemented method of claim 1 (as rejected above).

Petropoulos does not explicitly disclose

wherein the second electronic document comprises an electronic document that includes functionality to permit the user to purchase one or more items.

However, Ogura teaches an online shopping environment allowing a user to purchase a piece of merchandising from a browsing site ([0158]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include online shopping functionality. The rationale for combining in this manner is that both Petropoulos and Ogura are directed to advertising via an online environment. Furthermore, this inclusion would enable Petropoulos to provide a user the ability to purchase desired merchandise, thus increasing revenue for the online system and further increasing campaign success for both the direct online system as well as any third-party merchants connected with the online environment.

**30. Claims 17 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petropoulos et al. (US 2003/0146939 A1) (hereinafter Petropoulos) in view of Ogura et al. (US 2002/0165767 A1) (hereinafter Ogura) as applied to claims 13, 16, 30, 33, 47 and 50 above, and further in view of Morgenthaler et al. (U.S. 2002/0032677) (hereinafter Morgenthaler).**

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31. As per claim 17 (and similarly as per apparatus claim 34), Petropoulos in view of Ogura discloses the computer-implemented method of claim 16 (as rejected above).

Petropoulos does not explicitly disclose further comprising:  
receiving feedback information related to a user's purchase of one or more items.

However, Morgenthaler teaches monitoring a user's Internet use habits and items purchased on the Internet via a cookie ([0055]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos and Ogura to include tracking user purchases. The rationale for combining in this manner is that Petropoulos, Ogura and Morgenthaler are all directed to advertising via an online environment. Furthermore, tracking user purchases would enable Petropoulos and Ogura to determine the effectiveness of an advertisement and adjust the campaign accordingly to achieve and maintain successful results.

32. **Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petropoulos et al. (US 2003/0146939 A1) (hereinafter Petropoulos) in view of Morgenthaler et al. (U.S. 2002/0032677) (hereinafter Morgenthaler).**

33. As per claim 51, Petropoulos discloses the apparatus of claim 49 (as rejected above).

Petropoulos does not explicitly disclose further comprising a feedback module that receives feedback information related to a user's purchase of one or more items.

However, Petropoulos does teach a user's use of preview information is monitored while the user reviews the results page. More specifically, it monitors which result is being previewed by order or rank, the length of each preview, whether there is a click-through, etc. The attributes of user behavior are forwarded across the network and later used to improve relevancy ([0072-79])

In addition, Morgenthaler teaches monitoring a user's Internet use habits and items purchased on the Internet via a cookie ([0055]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include tracking user purchases. The rationale for combining in this manner is that Petropoulos and Morgenthaler are directed to advertising via an online environment. Furthermore, tracking user purchases would enable Petropoulos to determine the effectiveness of an advertisement and adjust the campaign accordingly to achieve and maintain successful results.

***Response to Arguments***

34. Applicant's arguments filed 11/13/2009 have been fully considered but they are not persuasive.

35. In the remarks, the Applicant argues the following with respect to claim 1, **as amended**:

*(a) the relied upon portions of Petropoulos do not identify any electronic advertisement, much less "identifying, at a server, an electronic advertisement including a compact display format, an expanded display format and code a client device uses to transition the electronic advertisement from the compact display format into the expanded display format...Applicant asserts that the relied upon portions of Petropoulos related to a search result and associated preview web page is not the same as Applicant's claimed element;*

*(b) the search result page displayed in the Petropoulos system does not include all three of a compact display format, an expanded display format, and code a client device uses to transition the electronic advertisement from the compact display format into the expanded display format;*

*(c) there is no teaching or suggestion in the relied upon portions that two display formats of an advertisement are delivered as part of a single electronic advertisement...as described in the relied upon portions of the reference, the two different elements are delivered sequentially at two different times...the search result and the preview do not also include code that allows for the transition;*

*(d) Petropoulos does not teach or suggest "identifying a second electronic document...and including the electronic advertisement in the second electronic document...in fact the concept of identifying a document and including the electronic advertisement in the second electronic document are completely missing from Petropoulos;*

*(e) the Examiner notes...it would be an obvious design choice to program the browser to display in such a fashion as claimed in the instant application (See Office Action, pg 12); and*

*(f) the Examiner appears to be taking Official Notice...*

In response to these arguments, the Examiner respectfully disagrees.

36. As per arguments (a) and (b), the Examiner notes that Petropoulos clearly identifies an electronic advertisement. As stated numerous times, the Examiner is properly construing a search result served in response to a search query as an advertisement. As stated in a previous response to arguments, the Examiner understands the claimed limitations to have the following equivalencies:

compact format: search result, Fig. 1, "53"

expansion icon: preview icon, Fig. 1, "63/64"

expanded format: preview window, Fig. 1, "55"

Based on this understanding, it is clear that the electronic advertisement is indeed in two formats. Furthermore, it is clear that upon interaction with the disclosed preview icon, code is enacted to then display the compact format in an expanded format. Moreover, based on the current remarks and previous responses from the Applicant, it appears the Applicant is interpreting the applied Petropoulos reference too narrowly with regards to operations being performed "at the server". The Examiner notes that [0065-70] of Petropoulos disclose that operations of the Petropoulos system are clearly performed at the server location and not

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limited to just a client-side operation. As such, the Examiner understands these disclosures are equivalent to the Applicant's claimed invention and thereby fully satisfy the limitations as currently claimed.

37. As per argument (c), as stated above, it is clear that the electronic advertisement is indeed in two formats. Based on a broadest reasonable interpretation, the Examiner understands both the search result and the preview window (i.e. the two formats) are part of a single advertisement, as they essentially advertise the same content, albeit in two different formats. Furthermore, it is clear that upon interaction with the disclosed preview icon, code is enacted to then display the compact format in an expanded format. As to the Applicant's assertion "the two different elements are delivered sequentially at two different times", the Examiner respectfully disagrees. The Examiner notes that the two display formats may be "displayed" at different times, but there is no indication that the "delivery" of these two elements is at two different times. In fact, to the contrary, the Examiner notes that in [0042], Petropoulos discloses that the preview information is displayed in a window "which already exists on results page 59 such as preview window 55". *(emphasis added)* The Examiner understands that if the window

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already exists on the page, then it is reasonable to understand the coding for both formats are delivered at the same time. Furthermore, as per [0048-51], Petropoulos discloses floating preview windows that appear to display the "designated preview information". The Examiner understands this recitation to mean that information has already been designated to be previewed once the initial format has been interacted with. Therefore, it would be reasonable to understand both elements have been delivered with the initial webpage.

38. As per argument (d), the art rejection above discloses that the identifying step is done based on the activity of the expanded display format resulting in a call to the referenced page. The "including" step has been addressed in the obviousness rejection above.

39. As per argument (e), the Examiner notes that nowhere in the section cited by the Applicant was there an "obvious design choice" rationale provided in the previous rejection.

40. As per argument (f), the Examiner notes the following:

As per MPEP 2143(G) (1), "a finding that there was some teaching, suggestion, or motivation, either in the references

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themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings". Furthermore, as per MPEP 2144(I), "the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)".

The Examiner has not taken "Official Notice", but rather provided a rationale which is based on generally available knowledge to one of ordinary skill in the art.

41. The Examiner hereby maintains the rejection of amended claim 1. The Examiner also maintains the rejection of amended claims 18, 35 and 52 for similar reasons. The Examiner maintains the rejection of dependent claims 2-17, 19-34 and 36-51. Moreover, the newly added claim 53 has been fully addressed in the rejection above.

***Conclusion***

42. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **DeGross (US 2002/0113815 A1) .**

43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM A. BRANDENBURG whose telephone number is (571)270-5488. The examiner can normally be reached on Monday-Thursday 6:30 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/W. A. B./  
Examiner, Art Unit 3622

/John Van Bramer/  
John Van Bramer  
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